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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91214782
Party	Defendant Subjekt LLC
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Date	07/16/2014
Attachments	Subjekt LLC - Answer.pdf(136565 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Skullcandy, Inc.,)	Opposition No. 91214782
)	U.S. Serial No. 85/884,443
Opposer,)	
)	Mark: 
)	
v.)	
)	
)	
SUBJEKT LLC,)	
)	
Applicant)	
)	

ANSWER TO NOTICE OF OPPOSITION

Subjekt LLC ("Applicant") hereby answers the Notice of Opposition ("Opposition") filed by Skullcandy, Inc. ("Opposer"). Applicant lacks sufficient knowledge or information to form a belief as to the truth of the allegations in the unnumbered introductory paragraph of the Opposition and the next to last unnumbered paragraph of the Opposition, both of such paragraphs stating that Opposer believes that it will be damaged by registration of Applicant's Mark, and on that basis denies such allegations contained therein. In response to the individually numbered paragraphs of the Opposition, Applicant responds as follows:

1. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 1 of the Opposition, and on that basis denies each and every allegation contained therein.
2. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 2 of the Opposition, and on that basis denies each and every allegation contained therein.

3. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 3 of the Opposition, and on that basis denies each and every allegation contained therein.

4. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 4 of the Opposition, and on that basis denies each and every allegation contained therein.

5. Applicant admits the allegation in Paragraph 5 of the Opposition that Applicant filed an application to register its Mark on March 22, 2013 with Serial No. 85/884,443 for "Headphones; Audio headphones; Headphones including attached lanyard; Personal headphones for sound transmitting apparatuses; Personal headphones for use with sound transmitting systems; Stereo headphones; Earphones; Audio earphones; Earphones including attached lanyard; Personal earphones for use with sound transmitting systems; Stereo earphones; Protective covers and cases for cell phones, tablet computers and media players" in Class 9 but is without sufficient knowledge or information to form a belief as to the truth of the rest of allegations contained in Paragraph 5 of the Opposition regarding Opposer's alleged prior rights in and to the Skull Design Mark and that Applicant's Mark appears on what Opposer alleges is the specimen of use that Applicant submitted with its Application for the Mark, and on that basis denies such allegations.

6. Applicant denies each and every allegation in Paragraph 6 of the Opposition.

7. Applicant is without sufficient knowledge or information to form a belief as to the truth of the allegations contained in Paragraph 7 of the Opposition, and on that basis denies each and every allegation contained therein.

8. Applicant denies each and every allegation in Paragraph 8 of the Opposition.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED

9. The Opposition fails to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

NO LIKELIHOOD OF CONFUSION

10. There is no likelihood of confusion between Applicant's Mark and Opposer's Skull Design Mark because Applicant's Mark has a wholly different appearance and commercial impression from Opposer's Skull Design Mark. Furthermore, there is no indication that there has been actual confusion between Applicant's Mark and Opposer's Skull Design Mark.

THIRD AFFIRMATIVE DEFENSE

NO INJURY OR DAMAGE

11. Opposer's claim is barred because Opposer has not and will not suffer any injury or damage from the registration of Applicant's Mark because there is no likelihood of confusion between Applicant's Mark and Opposer's Skull Design Mark.

THIRD AFFIRMATIVE DEFENSE

UNCLEAN HANDS

12. Opposer's claim is barred by the doctrine of unclean hands through Opposer's attempt to monopolize Class 9 beyond the boundaries of any alleged rights it might have, if any, by filing oppositions and extensions of time to file oppositions against applications in Class 9 that incorporate faces or skulls as part of the marks in question regardless of whether there is a likelihood of confusion between such marks and Opposer's Skull Design Mark.

13. Opposer relies on the fact that any of such opposed applicants will default instead of incurring the expense of an opposition proceeding.

14. Opposer does not file oppositions against applications in Class 9 that incorporate faces or skulls as part of the marks in question when the owners of such applications are large corporations that can easily afford to fight an opposition proceeding.

FOURTH AFFIRMATIVE DEFENSE

NARROW RIGHTS / CROWDED FIELD

15. Opposer's Skull Design Mark is composed of the image of a stylized skull in profile. The adoption and use of the image of a skull is part of numerous federally

registered third party marks in Class 9 that are not owned by Opposer, showing that the image of a skull is commonplace in Class 9. Accordingly, the Skull Design Mark is weak as a source indicator in Class 9.

16. Opposer is seeking to expand its rights in its particularly stylized skull in profile to preclude the registration of not only other marks in Class 9 that include any sort of a skull whether in profile or not, but also Applicant's Mark which is not composed of a skull at all, but rather the head of a headphone-wearing alien staring straight at the viewer.

17. The numerous marks not owned by Opposer in Class 9 that are composed of skulls weighs against a finding of likelihood of confusion between Applicant's Mark and Opposer's Skull Design Mark because such other skull marks are more similar to Opposer's Skull Design Mark than Applicant's Mark is.

18. As such, Opposer's rights regarding its Skull Design Mark must be narrowly construed so that the Skull Design Mark cannot form the basis of a likelihood of confusion claim against Applicant's Mark, which is not composed of the image of a skull and bears no resemblance to the Skull Design Mark.

SIXTH AFFIRMATIVE DEFENSE

LACK OF SECONDARY MEANING

19. Opposer's claim is barred because Opposer's Skull Design Mark lacks secondary meaning. As stated earlier, Opposer's Skull Design Mark is composed of a skull, which is a common shape for a design mark in Class 9 that renders it incapable of being distinguished from other marks in Class 9 that contain a skull.

SEVENTH AFFIRMATIVE DEFENSE

LACHES

20. Opposer's claim is barred by the doctrine of laches because Opposer has caused prejudice to Applicant by only quite recently objecting to Applicant's use of Applicant's Mark, even though Applicant has been using Applicant's Mark for years in the marketplace.

EIGHTH AFFIRMATIVE DEFENSE

AQUIESCENCE

21. Opposer's claim is barred by the doctrine of acquiescence because Opposer acquiesced to Applicant's use of Applicant's Mark by not objecting to its use for years.

NINTH AFFIRMATIVE DEFENSE

ESTOPPEL

22. Opposer's claim is barred by the doctrine of estoppel because Applicant would suffer great prejudice if its Mark were refused registration because of Opposer's acquiescence to Applicant's use of Applicant's Mark for years in the marketplace.

TENTH AFFIRMATIVE DEFENSE

RESERVATION OF RIGHTS

23. Applicant reserves right to amend its answer to add additional or other affirmative defenses as may become necessary after a reasonable opportunity for appropriate discover.

WHEREFORE, Applicant requests dismissal of the Opposition and issuance of a registration of its Application Serial No. 85/884,443 and such other and further relief as may be just and proper.

Respectfully Submitted,

Dated: July 16, 2014

By: 

Kia Kamran, Esq.

Attorney for Applicant

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PROOF OF SERVICE

I hereby certify that a true and complete copy of the foregoing **ANSWER TO THE NOTICE OF OPPOSITION** has been served on Opposer's counsel via First Class U.S. Mail on July 16, 2014, postage prepaid to:

Andrew J. Avsec
BRINKS GILSON & LIONE
P.O. Box 10395
Chicago, IL 60610

A handwritten signature in black ink, appearing to read 'Kia Kamran', is written over a horizontal line.

Kia Kamran, Esq.